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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/123,145	07/27/1998	KENZO SEKIGUCHI	1232-4458	5208

27123 7590 03/23/2005

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EXAMINER	
POKRZYWA, JOSEPH R	
ART UNIT	**PAPER NUMBER**
2622	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/123,145	SEKIGUCHI, KENZO	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-46,56 and 57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *43-46,56 and 57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/9/05 has been entered.

Response to Amendment

2. Applicant's amendment received on 1/10/05 has been entered and made of record. Currently, **claims 43-46, 56, and 57** are pending.

Claim Objections

3. **Claim 56** is objected to because of the following informalities:

in ***claim 56***, line 20, the first occurrence of the phrase "reception step" should read "reception date".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 43-46, 56, and 57** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (U.S. Patent Number 5,521,719, cited in the Office action dated 11/8/04) in view of Wada *et al.* (U.S. Patent Number 5,442,686).

Regarding ***claim 43***, Yamada discloses a communication apparatus (apparatus 111, seen in Figs. 9 and 10) comprising means for connecting to a computer network (LAN I/F 123, column 14, lines 4 through 7), means for connecting to a public telephone network (facsimile communication unit 117, column 13, lines 36 through 63), facsimile reception means for receiving facsimile image data from a transmitting source via the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), returning means for returning a message (see Fig. 14, CED message) in response to a request (CNG message) received from the transmitting source via the public telephone network (see Figs. 3 and 14, column 7, line 63 through column 9, line 26, and column 18, lines 47 through 58), first instruction reception means for receiving an instruction generated based on the message returned by the returning means (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), second instruction reception means for receiving an instruction indicating a facsimile communication without reception of the instruction by the first instruction

reception means (see Figs. 11-14, being the SUB signal, having a procedure number code "03", "13", or "23", therein not receiving the first instruction, column 15, lines 13 through 19, column 16, lines 21 through 27, and column 17, lines 40 through 45), conversion means for converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), processing means for processing the facsimile image data received by the facsimile reception means without performing the converting by the conversion means in a case where the second instruction reception means receives the instruction (column 15, lines 13 through 53, column 16, line 22 through column 17, line 8, and column 17, line 41 through column 18, line 16), recognition means for recognizing a telephone number of the transmitting source (column 7, line 63-column 8, line 19, wherein within the phase B of G-3 facsimile protocol, a TSI signal is inherently received and detected), and transmission means for transmitting the e-mail data converted by the conversion means in accordance with the instruction received by one of the first and second reception means (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

However, Yamada fails to expressly disclose of a recognition means for recognizing a telephone number of the transmitting source and a reception date of the facsimile image data received by the facsimile reception means, and subsequently, transmission means for transmitting the e-mail data in accordance ...with the telephone number and the reception date recognized by the recognition means.

Wada discloses a communication apparatus (see Fig. 1) comprising means for connecting to a public telephone network (telephone line 2a, column 3, lines 15-35), facsimile reception

means for receiving facsimile image data from a transmitting source via the public telephone network (column 3, line 60-column 4, line 7), returning means for returning a message in response to a request received from the transmitting source via the public telephone network (see Fig. 3A, CED, NSF,CSI, and DIS, being in response to the CI request, column 8, lines 4-11), first instruction reception means for receiving an instruction generated based on the message returned by the returning means (column 7, line 29-column 8, line 31, see Figs. 3A and 3B), second instruction reception means for receiving an instruction indicating a facsimile communication without reception of the instruction by the first instruction reception means (column 7, line 29-column 8, line 31, see Figs.3A and 3B), conversion means for converting the received facsimile image data into *a data format* (column 3, line 61-column 4, line 19), recognition means for recognizing a telephone number of the transmitting source and a reception date of the facsimile image data received by the facsimile reception means (column 5, lines 3-44, and column 7, lines 29-44), and transmission means for transmitting *the data* converted by the conversion means in accordance with the instruction received by one of the first and second reception means with the telephone number and the reception date recognized by the recognition means (column 5, line 45-column 6, line 2, and column 6, line 53-column 7, line 61).

Yamada & Wada are combinable because they are from the same field of endeavor, being facsimile machines that receive facsimile data using standard facsimile protocol. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have Yamada's system include the facsimile protocol recognition means, as taught by Wada, so that Yamada's system would include a recognition means for recognizing a telephone number of the transmitting source and a reception date of the facsimile image data received by the facsimile

reception means, and subsequently, transmission means for transmitting the e-mail data in accordance ...with the telephone number and the reception date recognized by the recognition means. The suggestion/motivation for doing so would have been that Yamada's system would conform with well-known standards of facsimile communication, as recognized by Wada in column 1, lines 20-68. Therefore, it would have been obvious to combine the teachings of Wada with the system of Yamada to obtain the invention as specified in claim 43.

Regarding ***claim 44***, Yamada and Wada disclose the apparatus discussed above in claim 43, and Wada further teaches that the returning means returns the response message as voice guidance information (column 9, line 33-column 10, line 68).

Yamada & Wada are combinable because they are from the same field of endeavor, being facsimile machines that receive facsimile data using standard facsimile protocol. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the further voice guidance teachings of Wada in the system of Yamada. The suggestion/motivation for doing so would have been that Yamada's system would become more user-friendly with the incorporation of Wada's teachings, since message senders would be given guidance information to assist in the operation, as read in column 9, line 33-column 10, line 68. Therefore, it would have been obvious to combine the teachings of Wada with the system of Yamada to obtain the invention as specified in claim 44.

Regarding ***claim 45***, Yamada and Wada disclose the apparatus discussed above in claim 43, and Yamada further teaches that the instruction reception means receives the instruction by a tone signal (column 7, line 63 through column 9, line 14).

Regarding ***claim 46***, Yamada and Wada disclose the apparatus discussed above in claim 45, and Yamada further teaches that the tone signal is a DTMF signal (column 8, line 52 through column 9, line 14, and column 19, line 61 through column 20, line 23, wherein the PB signal, as well as the keyed input registered data, each would inherently be a DTMF signal).

Regarding ***claim 56***, Yamada discloses a method for a communication apparatus (apparatus 111, seen in Figs. 9 and 10) comprising connecting to a computer network (via LAN I/F 123, column 14, lines 4 through 7), connecting to a public telephone network (via facsimile communication unit 117, column 13, lines 36 through 63), receiving facsimile image data from a transmitting source via the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), returning a message (see Fig. 14, CED message) in response to a request (CNG message) received from the transmitting source via the public telephone network (see Figs. 3 and 14, column 7, line 63 through column 9, line 26, and column 18, lines 47 through 58), receiving first instruction generated based on the message returned by a returning means (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), receiving second instruction indicating a facsimile communication without reception of the first instruction received by the first instruction reception step (see Figs. 11-14, being the SUB signal, having a procedure number code "03", "13", or "23", therein not receiving the first instruction, column 15, lines 13 through 19, column 16, lines 21 through 27, and column 17, lines 40 through 45), converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), processing the facsimile image

data received by a facsimile reception means without performing the converting by the conversion step in a case where the second instruction reception step receives the instruction (column 15, lines 13 through 53, column 16, line 22 through column 17, line 8, and column 17, line 41 through column 18, line 16), recognizing a telephone number of the transmitting source (column 7, line 63-column 8, line 19, wherein within the phase B of G-3 facsimile protocol, a TSI signal is inherently received and detected), and transmitting the e-mail data converted by the conversion step in accordance with the instruction received by the instruction by one of the first and second instruction reception step (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

However, Yamada fails to expressly disclose of a recognition means for recognizing a telephone number of the transmitting source and a reception date of the facsimile image data received by the facsimile reception means, and subsequently, transmission means for transmitting the e-mail data in accordance ...with the telephone number and the reception date recognized by the recognition means.

Wada discloses a method for a communication apparatus (see Figs. 1-4) comprising connecting to a public telephone network (telephone line 2a, column 3, lines 15-35), receiving facsimile image data from a transmitting source via the public telephone network (column 3, line 60-column 4, line 7), returning a message in response to a request received from the transmitting source via the public telephone network (see Fig. 3A, CED, NSF, CSI, and DIS, being in response to the CI request, column 8, lines 4-11), receiving first instruction generated based on the message returned by a returning means (column 7, line 29-column 8, line 31, see Figs. 3A and 3B), receiving second instruction indicating a facsimile communication without reception of

the first instruction received by the first instruction reception step (column 7, line 29-column 8, line 31, see Figs.3A and 3B), converting the received facsimile image data into *a data format* (column 3, line 61-column 4, line 19), recognizing a telephone number of the transmitting source and a reception date of the facsimile image data received by the facsimile reception step (column 5, lines 3-44, and column 7, lines 29-44), and transmitting *the data* converted by the conversion step in accordance with the instruction received by one of the first and the second instruction reception step with the telephone number and the reception date recognized by the recognition step (column 5, line 45-column 6, line 2, and column 6, line 53-column 7, line 61).

Yamada & Wada are combinable because they are from the same field of endeavor, being facsimile machines that receive facsimile data using standard facsimile protocol. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have Yamada's system include the facsimile protocol recognition means, as taught by Wada, so that Yamada's system would include a recognition means for recognizing a telephone number of the transmitting source and a reception date of the facsimile image data received by the facsimile reception means, and subsequently, transmission means for transmitting the e-mail data in accordance ...with the telephone number and the reception date recognized by the recognition means. The suggestion/motivation for doing so would have been that Yamada's system would conform with well-known standards of facsimile communication, as recognized by Wada in column 1, lines 20-68. Therefore, it would have been obvious to combine the teachings of Wada with the system of Yamada to obtain the invention as specified in claim 56.

Regarding ***claim 57***, Yamada discloses a computer program for a communication apparatus (apparatus 111, seen in Figs. 9 and 10, column 13, lines 18 through 20) comprising

computer readable program code means for connecting to a computer network (LAN I/F 123, column 14, lines 4 through 7), computer readable program code means for connecting to a public telephone network (facsimile communication unit 117, column 13, lines 36 through 63), computer readable program code means for receiving facsimile image data from a transmitting source via the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), computer readable program code means for returning a message (see Fig. 14, CED message) in response to a request (CNG message) received from the transmitting source via the public telephone network (see Figs. 3 and 14, column 7, line 63 through column 9, line 26, and column 18, lines 47 through 58), computer readable program code means for receiving first instruction generated based on the message returned by a returning means (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), computer readable program code means for receiving second instruction indicating a facsimile communication without reception of the first instruction received by the first instruction reception code means (see Figs. 11-14, being the SUB signal, having a procedure number code "03", "13", or "23", therein not receiving the first instruction, column 15, lines 13 through 19, column 16, lines 21 through 27, and column 17, lines 40 through 45), computer readable program code means for converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), computer readable program code means for processing the facsimile image data received by the facsimile reception code means without performing the converting by the conversion code means in a case where the second instruction reception code

means receives the instruction (column 15, lines 13 through 53, column 16, line 22 through column 17, line 8, and column 17, line 41 through column 18, line 16), computer readable program code means for recognizing a telephone number of the transmitting source (column 7, line 63-column 8, line 19, wherein within the phase B of G-3 facsimile protocol, a TSI signal is inherently received and detected), and computer readable program code means for transmitting the e-mail data converted by the conversion means in accordance with the instruction received by the instruction by one of the first and second instruction reception code means (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

However, Yamada fails to expressly disclose of a recognition means for recognizing a telephone number of the transmitting source and a reception date of the facsimile image data received by the facsimile reception means, and subsequently, transmission means for transmitting the e-mail data in accordance ...with the telephone number and the reception date recognized by the recognition means.

Wada discloses a method for communication apparatus (see Figs. 1-4) comprising means for connecting to a public telephone network (telephone line 2a, column 3, lines 15-35), facsimile reception means for receiving facsimile image data from a transmitting source via the public telephone network (column 3, line 60-column 4, line 7), returning means for returning a message in response to a request received from the transmitting source via the public telephone network (see Fig. 3A, CED, NSF, CSI, and DIS, being in response to the CI request, column 8, lines 4-11), first instruction reception means for receiving an instruction generated based on the message returned by the returning means (column 7, line 29-column 8, line 31, see Figs. 3A and

3B), second instruction reception means for receiving an instruction indicating a facsimile communication without reception of the instruction by the first instruction reception means (column 7, line 29-column 8, line 31, see Figs.3A and 3B), conversion means for converting the received facsimile image data into *a data format* (column 3, line 61-column 4, line 19), recognition means for recognizing a telephone number of the transmitting source and a reception code of the facsimile image data received by the facsimile reception means (column 5, lines 3-44, and column 7, lines 29-44), and transmission means for transmitting *the data* converted by the conversion means in accordance with the instruction received by one of the first and second reception means with the telephone number and the reception code recognized by the recognition means (column 5, line 45-column 6, line 2, and column 6, line 53-column 7, line 61).

Yamada & Wada are combinable because they are from the same field of endeavor, being facsimile machines that receive facsimile data using standard facsimile protocol. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have Yamada's system include the facsimile protocol recognition means, as taught by Wada, so that Yamada's system would include a recognition means for recognizing a telephone number of the transmitting source and a reception date of the facsimile image data received by the facsimile reception means, and subsequently, transmission means for transmitting the e-mail data in accordance ...with the telephone number and the reception date recognized by the recognition means. The suggestion/motivation for doing so would have been that Yamada's system would conform with well-known standards of facsimile communication, as recognized by Wada in column 1, lines 20-68. Therefore, it would have been obvious to combine the teachings of Wada with the system of Yamada to obtain the invention as specified in claim 57.

Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Srinivasan (U.S. Patent Number 6,072,862) discloses a message delivery system;

Owens *et al.* (U.S. Patent Number 6,023,700) discloses an electronic mail distribution system;

Yamamoto *et al.* (U.S. Patent Number 5,767,985) discloses a system of transmitting receiving facsimile data as e-mail; and

Baudoin (U.S. Patent Number 5,406,557) discloses a electronic mail hub system.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146 or (571) 272-7410 after March 30, 2005. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp